

Serial No. 08/421,055
Page 2

Applicants' Response:

Claims 14, 15 and 30 have been cancelled. Therefore, this rejection is now moot.

Double Patenting Rejection of Claims 6-32

Claims 6-32 were rejected again under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1, 8, 12-13, and 20-32 of U.S. Patent No. 5, 964,979 (George et al.) for the same reasons as set forth in paragraph 6 of the previous office action. The Office Action further states that

... the "two way" test for patentability is seen to be NOT applicable in the instant case, since while the instant invention and that of George et al. may be related (on their respective faces) as genus-species, the two inventions are seen to be completely different i.e., the invention of George et al. is seen to be a new invention relative to the instant invention, there being no apparent evidence that the later filed invention is or was ever even intended or envisioned as being an IMPROVEMENT over the instant invention i.e. the invention of George et al. is apparently not (i.e. nowhere disclosed or indicated as being envisioned as) an IMPROVEMENT over the invention set forth in the instant application, which foregoing constitutes a necessary criterion or requirement for the application of this NARROW EXCEPTION to the general rule of the "one way" test viz. the "two way" test as set forth in all of Borah, Braat and Berg.

Applicants' Response

Applicants agree with the position taken by the Examiner that the invention of George et al. is patentably distinct from the instant invention. However, contrary to the position the Examiner appears to be taking, the fact that two inventions are patentably distinct does not preclude one being an IMPROVEMENT over the other. The Examiner concludes that the invention of George et al. is not an IMPROVEMENT of the instant invention, without providing any criteria for determining what constitutes an IMPROVEMENT invention and why the invention of George et al. is not one. It is submitted that there is evidence, on their faces, that the invention of George et al. was an IMPROVEMENT over the instant invention. For example, the two inventions share three of the same inventions^{ORS}; they relate to similar technology and they are owned by the same assignee.

Serial No. 08/421,055
Page 3

It is submitted that the current situation justifies the application of the "two-way" test. An obviousness-type double patenting rejection can be overcome with a timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c). However, the filing of a terminal disclaimer in this case is problematic and highlights why this double patenting rejection should be withdrawn. The USPTO has found the later filed invention of George et al. to be patentable over the instant invention (see the file history of George et al.). If a terminal disclaimer is filed in the instant case, there is no term to disclaim, because George et al. was filed after the instant application. If the instant application was given the same term as that of George et al., the term of the instant invention would actually be extended beyond what is statutorily permitted.

Accordingly, the "two-way" test applies to the current situation and the obviousness issue turns on the additional structure claimed in the George et al patent not the obviousness of the basic structure claimed in the current application. Because the invention of George et al. is not obvious over the instant invention, a double-patenting rejection is not appropriate. Accordingly, it is respectfully requested that the double-patenting rejection be withdrawn.

Rejection of Claims 6-9, 12-32 Under 35 U.S.C. 103

Claims 6-8, 14-16, 20-26, and 29-32 were again rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al. Claims 12-13 were again rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further taken in combination with Pletcher. Claims 9 and 28 were again rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further taken in combination with Schappert et al. Claims 17-19 and 27 were again rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further taken in combination with Kan.

In addition to adhering to the reasons for these rejections that is of record in the last Office Action (see para. 9-12), the Examiner also stated:

Serial No. 08/421,055
Page 4

(a) Applicants' contentions and arguments with respect to the word "topography" are seen to have merit; however, since this word (by applicants' own dictionary excerpt submission) defines the features of a surface (i.e., of an object) viz. a featured SURFACE, the word "surface" in line 7 of claim 6 is therefore seen to be redundant; and (b) for applications filed BEFORE 29 November 1999, prior art applicable only under U.S.C. 102(e) is NOT disqualified, precluded or prohibited from being properly applicable under the provisions of 35 U.S.C. 103(c), i.e., N.B. M.P.E.P. 706.02(1), second paragraph."

Applicants' Response:

Just as a point of clarification, the Examiner is requested to note that the word "surface" in line 7 of claim 6 refers to the surface of the substrate on which the article is placed. The article comprises a melt-flowable composition and a dimensionally stable film. The article is place on the surface of the substrate such that the melt-flowable composition contacts the surface of the substrate. The word "topography" refers to the dimensionally stable film having a surface topography. The surface of the dimensionally stable film is not the same as the surface of the substrate.

Applicants resubmit that the present claims are not obvious in light of the art cited above for the same reasons stated in their response to the last Office Action. Thos reasons are reiterated below, for the Examiner's convenience.

Each of these rejections is based on various combinations of cited patents, all identify Kinzer at al. as the primary patent reference. The rejection is traversed because Kinzer at al. is not believed to be prior art to the pending patent application, according to paragraph 3(c) of section 103. The present application has a filing date of April 12, 1995, while Kinzer et al. has a filing date of May 22nd, 1995, a priority date of June 16, 1993, and an issue date of February 4, 1997. Apparently, while not expressed in the Office Action, the Kinzer et al. reference is being asserted as prior art under section 103, through section 102(e). However, section 103(c) precludes the use of this reference as prior art when the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. section 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed

Serial No. 08/421,055

Page 5

invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants' request that the Examiner identify which portions of 35 U.S.C. sections 102 and 103 the Kinzer et al. reference is considered to fall under as a reference against Applicants' claims. Applicants believe that Kinzer et al., according to the new section 103(c) cited above, does not qualify as prior art against the pending claims because the new section 103(c) excludes 102(e) art from being used in an obviousness rejection under the stated circumstances. The outstanding rejections under 35 U.S.C. section 103 found in the Office Action, all of which use Kinzer et al. as the primary reference, should therefore be withdrawn and the claims allowed.

The Examiner is invited to contact the undersigned, at the Examiner's convenience, should the Examiner have any questions regarding this communication or the present patent application.

Respectfully Submitted,

Respectfully submitted,

By


Harold C. Knecht III

Registration Number 35,576	Telephone Number 651-575-1056
Date 1/22/03	

Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3427
Telephone: (651) 575-1056
Facsimile: (651) 736-3833